

**REMARKS**

**Status of the claims**

With the above amendments, claim 1 has been amended. Claims 1, 2, 4, and 5 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Support for the amendment to claim 1 can be found at page 6, lines 20-21. Reconsideration is respectfully requested in light of the following remarks.

**Rejections under 35 USC §103**

Claims 1, 2, 4, and 5 are rejected under 35 USC §103(a) as being unpatentable over Scholl '415 (US Patent No. 6,025,415) in view of Yagi '379 (JP 2000178379).

Applicants traverse.

The present invention, as recited in claim 1, relates to a rubber composition that comprises not only aluminum hydroxide having an average particle size of less than 25  $\mu\text{m}$ , but also 2 to 30 parts by weight of glass fibers. As described on page 22, lines 16 to 20 of the written description, performance on ice and snow and abrasion resistance can only be improved while maintaining dispersibility of the reinforcing agent, when both

of the above components are contained. As shown in Table 1 of the instant written description, the rubber composition of Example 1 is obtained by compounding aluminum hydroxide "HIGHLITE H43" and "10 parts by weight" of glass fibers, which is within the claimed range of 2 to 30 parts by weight of glass fibers. In contrast, comparative example 1 does not have the 2 to 30 parts by weight of glass fibers. Applicants note that the rubber composition of Example 1 is improved in performance on ice and in abrasion resistance while maintaining dispersibility of carbon black. In contrast, Comparative Example 1 does not possess these improved properties.

Accordingly, improvement in performance on ice and abrasion resistance while maintaining dispersibility of carbon black is achieved by compounding "2 to 30 parts by weight" of glass fibers, because a suitable amount of glass fibers protrude from the tread surface and therefore, a sufficient digging and scratching effect is obtained. Moreover, suitable block stiffness of tread rubber is obtained and the tread rubber surface can follow snowy and icy roads (please see the description on page 6, line 23 to page 7, line 5 of the specification).

In contrast to the instant invention, although Scholl '415 does disclose glass fibers (see column 5, line 23), the glass fibers are only one example of many examples of fillers and merely an optional component. Therefore, the Examiner appears to be using hindsight reconstruction to arrive at the instant invention. Moreover, the specification of Scholl '415 neither describes nor suggests containing 2 to 30 parts by weight of glass fibers. Further, the specification of Yagi '379 neither describes nor suggests compounding glass fibers. Thus, one of ordinary skill in the art would never consider improving performance on ice and abrasion resistance, while maintaining dispersibility of carbon black, by using glass fibers and aluminum hydroxide together, based on the disclosures of Scholl '415 and Yagi '379. The rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact the undersigned in the Washington metropolitan area at the phone number listed below.


Application No.: 09/903,694

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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